

REMARKS/ARGUMENTS

Claims 102, 103 and 175-191 are pending in the application. Claims 102, 175 and 176 have been canceled without prejudice or disclaimer, and new claims 192-215 have been added. No new matter has been added. Reconsideration of the claims is respectfully requested.

There is support in the specification for the new claims, including, but not limited to, paragraphs 40, 47, 57, 61, 63, 65, 95, 98, 101, 104-108, 131, and 136. These paragraph numbers correspond to those listed in the published version of the present application, Publication No. 2004/0156014.

Election/Restrictions

From the restriction requirement mailed on March 20, 2006, Applicant elected claims 102, 103, 175 and 176, all directed to a "multifocal ophthalmic lens", denoted as "invention II", in a response mailed on Apr. 27, 2006.

Claims 102, 175 and 176 are cancelled. New claims 192-215 are submitted, and Applicant asserts that new claims 192-215 also are directed to invention II, a "multifocal ophthalmic lens".

Double Patenting Rejection

In paragraph 5 on page 2 of the Office Action, claims 102, 103, 175, 176, 177, 178, 181, 182, 184, 186, 187 and 191 were provisionally rejected under the nonstatutory obvious-type double patenting as being unpatentable over claims 1-9, 11-34 and 43 of copending Patent Application No. 10/119,611 in view of U.S. Patent Number 5,699,142 ("Lee" et al.) Note that Patent Application No. 10/119,611 has issued as U.S. Patent No. 6,830,332 on December 14, 2004 to Piers, et al.

The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad*

Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." (MPEP 804.02(II))

Accordingly, a terminal disclaimer is filed to overcome the rejection over U.S. Patent No. 6,830,332, and is attached to this response.

Claim Rejections – 35 U.S.C. § 102

In paragraph 7 on page 4 of the Office Action, claims 102, 103, 175 and 176 are rejected under 35 U.S.C. §102(b) as being anticipated by Lee.

Claims 102, 175 and 176 are cancelled. Applicant asserts that amended claim 103 and new claims 192-215 are not anticipated by Lee.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicant respectfully submits that Lee does not teach every element of amended claim 103 and new claims 192 and 212, and therefore fails to anticipate amended claim 103 and new claims 192 and 212. Applicant believes amended independent claim 103 and new independent claims 192 and 212 are in condition for allowance. Reconsideration, allowance, and notice to that effect are respectfully requested.

Lee is directed to a diffractive, multifocal ophthalmic lens. Lee fails to disclose spherical aberration or an IOL that includes spherical aberration. In particular, Lee does not disclose either a lens spherical aberration or a cornea spherical aberration, as recited by amended claim 103 and new claim 192. More specifically, Lee does not teach or suggest having a lens shape with a negative spherical aberration as stated in claim 103.

In addition, because Lee fails to discuss chromatic aberration, Lee fails to disclose:

“a refractive chromatic aberration determined by the anterior radius, the posterior radius, the lens thickness, the refractive index and a cornea chromatic aberration; and a diffractive chromatic aberration determined by the diffractive portion; wherein the sum of the refractive chromatic aberration and the diffractive chromatic aberration is closer to zero than the refractive chromatic aberration alone”, as recited by new claim 193.

Further, with respect to new claim 212, Lee fails to teach or suggest any aspheric surfaces that would operate to reduce spherical aberration. The only curved refractive surface disclosed by Lee is spherical: “The term ‘base curve’ generally refers to the radius of a spherical 3-D surface.” (column 3, lines 26-27). Specifically, Lee does not teach or suggest that the “lens shape produces a lens spherical aberration; wherein the sum of the lens spherical aberration and a positive cornea spherical aberration is closer to zero than the cornea spherical aberration alone, for at least one of the far focus and the near focus.”

As a result, not all the elements or limitations of amended claim 103 and new claims 192 and 212 are found in Lee. Because Lee does not teach or suggest every limitation of amended claim 103 and new claims 192 and 212, Applicant believes amended claim 103 and new claims 192 and 212 are in condition for allowance. Reconsideration, allowance, and notice to that effect are respectfully requested.

Dependent claims 193-211, which are dependent from independent claim 192, include all of the limitations of claim 192 and recite additional features which further distinguish these claims from the cited reference. Therefore, dependent claims 193-211 are also in condition for allowance. Dependent claims 213-215, which are dependent from independent claim 212, include all of the limitations of claim 212 and recite additional features which further distinguish these claims from the cited reference. Therefore, dependent claims 213-215 are also in condition for allowance. Reconsideration, allowance, and notice to that effect are respectfully requested.

Claim Rejections – 35 U.S.C. § 103

In paragraph 9 on page 5 of the Office Action, claims 177-191 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0063254 ("Piers" et al.) in view of U.S. Patent No. 5,699,142 ("Lee" et al.).

A reference used in an anticipatory rejection under 35 U.S.C. 102(e), (f), or (g) is disqualified as prior art if evidence is provided to show common ownership by, or an obligation of assignment to, the same person at the time the invention was made. Such a commonly owned reference is disqualified when

- (A) proper evidence is filed,
- (B) the reference only qualifies as prior art under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999 (e.g. not 35 U.S.C. 102(a) or (b)) and
- (C) the reference was used in an obviousness rejection under 35 U.S.C. 103(a). (MPEP 706.02(I)(3))

Applicant asserts that conditions (A), (B) and (C) are all satisfied for Piers, thereby disqualifying Piers as a reference.

Condition (C) is clearly satisfied from the Office Action. The reference has a publication date of April 3, 2003, and the present application has a filing date of December 1, 2003; the reference would only qualify under 35 U.S.C. 102(e); condition

(B) is therefore satisfied. Proper evidence is provided in the following paragraph, thereby satisfying condition (A) (MPEP 706.02(I)(2)(II)):

Common ownership

Present application 10/724,852 and US Patent Application Publication Number 2003/0063254 were, at the time the invention of present application 10/724,852 was made, owned by Pharmacia Groningen BV.

Therefore, US Patent Application Publication Number 2003/0063254 ("Piers") may not be used in a rejection under 35 U.S.C. 103(a) against the claims of the present application 10/724,852. Without Piers, Lee alone does not teach or suggest all of the elements of claims 177-191, or amended claim 103 and new claims 192-214 for that matter. As such, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. 103(a) rejections.

Conclusions

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.


If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Scott Catlin, at (714) 247-8463.

Respectfully submitted,

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